

### REMARKS

Reconsideration of this application is respectfully requested.

Claims 14, 17, 20, 25, and 27-29 have been amended to recite a "eukaryotic expression vector." Claims 15 and 18 have been amended to recite a "mammalian expression vector." Claims 21 and 22 have been canceled. Upon amendment, claims 14-20, 23-25, and 27-29 are pending in this application. No new matter enters through this amendment.

Claims 14-29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Chang (U.S. Patent No. 6,001,977). It is the Examiner's position that the sequences of Chang's HIV-1 and applicants' HIV-1 are the same. Accordingly, the Examiner concludes that Chang anticipates applicants' claims.

Applicants traverse the rejection for the reasons previously presented in applicants' August 1, 2003, Amendment and Response to Paper No. 29.

Nevertheless, to expedite prosecution, applicants have amended claims 14, 15, 17, 18, 20, 25, and 27-29 to recite a "eukaryotic expression vector" or a "mammalian expression vector" and have canceled claims 21 and 22. As a result, all of applicants' pending claims recite a "eukaryotic expression vector," a "mammalian expression vector," or a "yeast expression vector" that expresses the HIV-1 Nef protein. Chang did not expressly disclose such a vector.

Moreover, Chang does not inherently disclose such a vector. Chang's HIV-1 clones  $\lambda$ BH5,  $\lambda$ BH8, and  $\lambda$ BH10 are lacking the LTR region upstream of the SstI site. Without an HIV-1 LTR, Chang's clones would not necessarily **express** applicant's claimed proteins in eukaryotic, mammalian, or yeast cells. Inherency may not be

established by probabilities or possibilities. *Finnigan Corp. v. ITC*, 51 U.S.P.Q.2d 1001, 1009 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.* Thus, Chang cannot anticipate applicants' pending claims under a theory of inherency. Accordingly, applicants respectfully request withdrawal of the rejection.

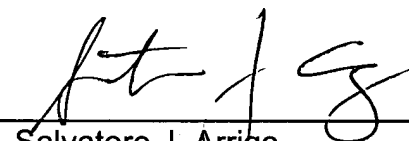
Applicants respectfully submit that this application is in condition for allowance. In the event that the Examiner disagrees, he is invited to call the undersigned to discuss any outstanding issues remaining in this application in order to expedite prosecution.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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